

#4

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Naoto NAKAMURA et al.

Application No.: 10/528,069

Filed: March 15, 2005

Docket No.: 122733

For: THERMAL TREATMENT APPARATUS, METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD FOR MANUFACTURING
SUBSTRATE

RECEIVED

PETITION UNDER 37 C.F.R. §1.47(a)

17 FEB 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**Legal Staff
International Division**

Sir:

Pursuant to 37 C.F.R. §1.47(a), this petition is filed to request acceptance and examination of the above-identified application without the signature on the Declaration of one of the five joint inventors of the claimed subject matter.

Attached hereto, in support of this Petition, is a Declaration Under 37 C.F.R. §1.47(a) of Mr. Akihiro Fukushima that includes personal knowledge of the facts summarized below relating to the unavailability of the joint inventor to sign the Declaration for this application.

The unavailable, and therefore non-signing joint inventor is Mr. Tomoharu Shimada.

Mr. Shimada's last known address is:

Postcode 854-0066

AD302, Petit Maison Kuyama-chuoh

1475, Kuyama, Isahaya-shi, Nagasaki, Japan

10/13/2005 GFREY1 00000133 10528069

02 FC:1464

130.00 0P

I. Background

U.S. Patent Application No. 10/528,069 was filed on March 15, 2005, in the U.S. Patent and Trademark Office without an executed Declaration. This application is a U.S. National Stage Application of PCT Application No. PCT/JP03/012353.

A Declaration signed by four of the five joint inventors, Naoto Nakamura, Iwao Nakamura, Kenishi Ishiguro and Sadao Nakashima, on behalf of themselves, and on behalf of Mr. Shimada is attached.

II. Statement of Facts

1. Mr. Shimada was employed by Hitachi Kokusai Electric Inc., 14-20, 3-chome, Higashi-Nakano, Nakano-Ku, Tokyo, Japan (hereinafter "HKE"). Mr. Shimada retired from the employment of HKE, and provided as contact information only a forwarding address, which he subsequently updated to the "last known address" indicated above.

2. A letter enclosing the complete application (including the specification, claims and drawings), and Declaration and Assignment documents relating to the subject application were sent to Mr. Shimada's last known address on April 6, 2005. This letter requested that Mr. Shimada sign/execute and return the Declaration and Assignment documents. No reply was received from Mr. Shimada regarding this letter. Copies of the May 23 letter and the certified mail receipt are attached to the accompanying Declaration under 37 C.F.R. §1.47(a) as Exhibits A and B.

3. Subsequently, a second letter, enclosing a second set of Declaration and Assignment documents, was sent to Mr. Shimada's last known address by certified mail on May 23, 2005. Copies of the May 23 letter and the certified mail receipt are attached are attached to the accompanying Declaration under 37 C.F.R. §1.47(a) as Exhibits C and D. To date, Mr. Shimada has not responded to the May 23 certified mail letter either.

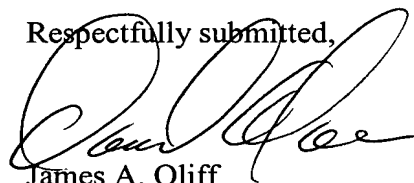
III. Actions Requested

Diligent efforts to contact Mr. Shimada at his last known address have failed. The facts relied upon to establish diligent effort are set forth in the enclosed Declaration under 37 C.F.R. §1.47(a). The last known address of Mr. Shimada is provided above.

In view of the foregoing, Applicants respectfully submit that the requirements of 37 C.F.R. §1.47(a) have been satisfied with regard to the unavailable inventor. Specifically, the following requirements have been met: (1) all four available joint inventors have made an Oath or Declaration on their behalf as required by 37 C.F.R. §1.63, and have made an Oath or Declaration on behalf of the unavailable non-signing joint inventor as required by 37 C.F.R. §1.64; (2) Applicants have provided proof of the pertinent facts surrounding the unavailability of the unavailable non-signing joint inventor; (3) Applicants have provided the last known address of the unavailable non-signing joint inventor; and (4) Applicants have paid the fee set forth in 37 C.F.R. §1.17(h). Check number 171604 for \$130.00 is attached. Please credit any overpayment or debit any underpayment to Deposit Account No. 15-0461. Two additional copies of this Petition are provided.

In view of the foregoing, Applicants respectfully request that this application be accepted for examination without Mr. Shimada's signature. If any further information is required in order to obtain acceptance and examination of this application pursuant to 37 C.F.R. §§1.47, 1.63 and/or 1.64, Applicants' representatives invite the Patent Office to contact them at the telephone number set forth below.

Respectfully submitted,



James A. Oliff

Registration No. 27,075

Daniel A. Tanner, III

Registration No. 54,734

JAO:DAT/scg

Attachments:

Declaration Under 37 C.F.R. §1.47(a) (with Exhibits A-D)

Declaration of Inventors

Date: October 7, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Naoto NAKAMURA et al.

Group Art Unit:

Application No.: 10/528,069

Examiner:

Filed: March 15, 2005

Docket No.: 122733

For: THERMAL TREATMENT APPARATUS, METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD FOR MANUFACTURING
SUBSTRATE

DECLARATION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Mr. Akihiro FUKUSHIMA, a Japanese citizen, hereby declare and state:

1. That I am the Assistant Manager of the Intellectual Property Section of Hitachi Kokusai Electric Inc.
2. That Naoto Nakamura, Iwao Nakamura, Kenichi Ishiguro, Sadao Nakashima, and Tomoharu Shimada are named as joint inventors of the subject matter of the claims for the above-identified application.
3. That, on June 30, 2004, Tomoharu Shimada retired from the employment of Hitachi Kokusai Electric Inc.
4. That Tomoharu Shimada left, as contact information, only a forwarding address, and specifically no telephone numbers, where he could be reached.
5. That, on April 6, 2005, I did send a letter by certified mail to Tomoharu Shimada at the forwarding address provided by Tomoharu Shimada, as his first known address. The first letter

sent by certified mail included a copy of the complete application (including the specification, claims and figures), an Assignment document for Tomoharu Shimada to execute assigning all rights in any patent issuing from the application to Hitachi Kokusai Electric Inc., and a Declaration document to be executed. This letter was sent to Tomoharu Shimada's first known address:

138, Shimashin, Takaoka-shi, Toyama, 939-1263 Japan

A copy of the certified letter is enclosed as Exhibit A. A copy of the registered delivery certificate mail receipt is attached as Exhibit B (relevant portions having been translated).

That, on May 23, 2005, I did send a letter by certified mail to Tomoharu Shimada at the forwarding address provided by Tomoharu Shimada, as his second (and last) known address. The second letter sent by certified mail included an Assignment document for Tomoharu Shimada to execute assigning all rights in any patent issuing from the application to Hitachi Kokusai Electric Inc., and a Declaration document to be executed. This letter was sent to Tomoharu Shimada's second (and last) known address:

AD302, Petit Maison Kuyama-chuoh, 1475, Kuyama, Isahaya-shi, Nagasaki, 854-0066
Japan

A copy of the certified letter is enclosed as Exhibit C. A copy of the registered delivery certificate mail receipt is attached as Exhibit D (relevant portions having been translated).

6. That these letters represent first and second attempt by me to have Tomoharu Shimada execute a Declaration document relating to this application.

7. That I confirmed the address of Mr. Tomoharu Shimada at the General Affairs Division in our company.

By my signature below, I attest that all statements made herein of my own knowledge are true, and all statements made on information and belief are believed to be true. I further attest my

understanding that these statements were made with the knowledge that willful false statements, and the like, so made are punishable by fine or imprisonment, or both, under Section 1003 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application, and any patent issuing thereon, or any patent to which this Declaration may be directed.

September 28, 2005
Date

Akihiro Fukushima
Akihiro Fukushima

Attachments:
Exhibits A-D (as identified above)

島田 智晴 様

2005年4月6日

知的財産部



特許外国出願のサイン書類の件

いつもお世話になっております。

さて首題の件ですが、下記案件につきまして外国出願致しました。

つきましては、添付の出願明細書を確認のうえ、サイン書類にサインおよび日付（英語）の記入をお願いします。

（サインする場所が決まっていますので間違えないようお願いします。）

記

対象案件

発明の名称：「熱処理装置及び半導体装置の製造方法」

発明者：島田智晴、中村直人、中村巖、石黒謙一、中嶋定夫

受付番号：20210144PCUS

書類返送期限：2005年4月19日（火）

書類返送先：株式会社日立国際電気

知的財産部

福島 宛て

以上

添付書類：サイン書類（DECLARATION, ASSIGNMENT）

2通

出願明細書

1通

〒164-8511

東京都中野区東中野3-14-20

TEL:03-3365-9262

FAX:03-3365-9264

Dear Mr. SHIMADA Tomoharu

April 6, 2005
Intellectual Property Division
Fukushima (Seal)

Re: Declaration and Assignment for the Foreign Patent Application

We always appreciate your cooperation.

We filed the under-identified application in the U.S.P.T.O.

Accordingly, please check the application documents including the specification, claims and figures, execute the Declaration and Assignment and date (in English).

(Please note that your signature block is defined. Thus, be careful not to make a mistake.)

Reference:

Title of the Invention:

Thermal Treatment apparatus, Method for Manufacturing
Semiconductor Device, and Method for Manufacturing
Substrate

Inventors: SHIMADA, Tomoharu NAKAMURA, Naoto
NAKAMURA, Iwao ISHIGURO, Kenichi
NAKASHIMA, Sadao

Reception Number: 20210144PCUS

Due date for returning the documents: April 19, 2005(Tuesday)

The documents should be returned to the following person:

Hitachi Kokusai Electric Inc.
Intellectual Property Division
FUKUSHIMA

Enclosures: The documents to be signed

(Declaration, Assignment)	2 sheets
Application documents	1 set

164-8511
14-20, Higashi-Nakano 3-chome, Nakano-ku, Tokyo
Tel: 03-3365-9262
Fax: 03-3365-9264

Exhibit B

書留・配達記録郵便物受領証(お客様控)

(差出人の住所氏名) 中野区東中野 3-14-20 (株)日立国際電気 知財財産部					様
受取人の氏名	引受番号	郵便料	申出損害要償額	摘要	
島田智晴 様	605-03-15975-4	600	---	記録	
様					
様					

ご注意 この受領証は、損害賠償の請求をするときその他の場合に必要です。大切に保存してください。
 簡易書留の損害賠償額は、原則として5万円を限度とする実損額です。
 摘要欄：カン(簡易)、キロ(配達記録)、ソク(速達)、ハイ(配達証明)の記号 ナイ(内容証明)、トク(特別送達)、ダイ(代金引換) シ(引受時刻証明)、シテ(配達日指定)
 配達状況がわかります。フリーダイヤル 0120-232886
 インターネット <http://www.post.japanpost.jp>

郵便局
落合
05.04.06*12-18

Exhibit D

書留・配達記録郵便物受領証(お客様控)

(差出人の住所氏名) 中野区東中野 3-14-20 (株)日立国際電気					様
受取人の氏名	引受番号	郵便料	申出損害要償額	摘要	
島田智晴 様	605-03-15975-4	810		記録	
様					
様					

ご注意 この受領証は、損害賠償の請求をするときその他の場合に必要です。大切に保存してください。
 簡易書留の損害賠償額は、原則として5万円を限度とする実損額です。
 摘要欄：カン(簡易)、キロ(配達記録)、ソク(速達)、ハイ(配達証明)の記号 ナイ(内容証明)、トク(特別送達)、ダイ(代金引換) シ(引受時刻証明)、シテ(配達日指定)
 配達状況がわかります。フリーダイヤル 0120-232886
 インターネット <http://www.post.japanpost.jp>

郵便局
17.5.23
12-18

BEST AVAILABLE COPY

Exhibit B

(Translation)

REGISTERED, DELIVERY CERTIFICATE MAIL RECEIPT (COPY)

(Name, Address of Sender)				
14-20, Higashi-Nakano 3-chome, Nakano-ku, HITACHI KOKUSAI ELECTRIC INC. INTELLECTUAL PROPERTY DIVISION				
Name of Addressee	Acceptance Number	Postal Fee	Legal Damages	Brief
SHIMADA, Tomoharu	605-03-15975-4	600yen		Delivery Certificate

Ochiai Post Office
 Date:
 April 6. 2005. 12-18

Exhibit D

(Translation)

REGISTERED, DELIVERY CERTIFICATE MAIL RECEIPT (COPY)

(Name, Address of Sender)				
14-20, Higashi-Nakano 3-chome, Nakano-ku, HITACHI KOKUSAI ELECTRIC INC. INTELLECTUAL PROPERTY DIVISION				
Name of Addressee	Acceptance Number	Postal Fee	Legal Damages	Brief
SHIMADA, Tomoharu	605-03-18056-6	410yen		Delivery Certificate

Ochiai Post Office
 Date:
 May 23. 2005. 12-18

島田 智晴 様

2005年5月23日
知的財産部特許出願のサイン書類の件

いつもお世話になっております。

さて首題の件ですが、先日4月6日付けで添付のご連絡を致しました。

書類は富山の住所に送付させて頂き、届いているようですが、サイン書類を返送して頂けませんでした。

今回改めて再度書類を送付させて頂きます。また、追加で2件別件の書類も送付させて頂きます。

返送用の封筒を同封致しますので、処理後、返送して頂きたく宜しくお願い申し上げます。

また、住所等が変更になっていましたら、移転先の住所、電話番号等ご連絡頂けると助かります。(今後の連絡に必要なため)

尚、書類にサイン等できない理由等がありましたら、お知らせ下さい。

記

対象案件

1. 外国出願のサイン書類

発明の名称：「熱処理装置及び半導体装置の製造方法」

発明者：島田智晴、中村直人、中村巖、石黒謙一、中嶋定夫

受付番号：20210144PCUS

サイン書類 (DECLARATION, ASSIGNMENT) に、サインおよび日付の記入をお願いします。

2. 宣誓書

発明の名称：「半導体製造装置」

出願番号：特願2003-008037 (日本)

出願番号：10/345190 (米国)

本出願に関し旭硝子株式会社殿より当社のアイデアであるとクレームがあり、本出願を旭硝子株式会社殿との共同出願にすることになりました。

従いまして、宣誓書およびサイン書類へ捺印をお願い致します。

書類返送期限：2005年6月2日 (木)

書類返送先：株式会社日立国際電気

知的財産部

福島 宛て

以上

添付書類： 前回送付した連絡文書 1 通
サイン書類 (DECLARATION, ASSIGNMENT) 各 1 通
宣誓書 1 通
サイン書類 (2 種類) 各 1 通

〒164-8511

東京都中野区東中野 3-1 4-2 0

TEL:03-3365-9262

FAX:03-3365-9264

E-mail:fukushima. akihiro@h-kokusai.com

Dear Mr. Tomoharu SHIMADA

May 23, 2005
Intellectual Property Division
Fukushima (Seal)

Re: Declaration and Assignment for the Foreign Patent Application

We always appreciate your cooperation.

We forwarded the letter to you as attached on April 6, 2005 relating to the under-identified matter.

We forwarded the letter to Toyama, which was the address of your residence and you seem to have received it. But we have not received the executed Declaration and Assignment from you.

Now, we again forward the letter enclosing the application documents to you. Also we enclose the other two application documents.

Here we enclose an envelope for your use of returning documents. After checking and executing these documents, please return them to us.

If your address is changed, please inform us of your new address, telephone number or any other contact number. (It is necessary for us to know your address when we send the documents in the future.)

If you have a reason for not executing the documents, please let us know.

Reference:

1. Declaration and Assignment for Foreign Application

Title of the Invention:

Thermal Treatment apparatus, Method for Manufacturing
Semiconductor Device, and Method for Manufacturing
Substrate

Inventors: SHIMADA, Tomoharu NAKAMURA, Naoto
NAKAMURA, Iwao ISHIGURO, Kenichi
NAKASHIMA, Sadao

Reception Number: 20210144PCUS

Please date and sign the Declaration and Assignment.

